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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,977	07/31/2003	Kyung-geun Lee	1293.1951	1858

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EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/630,977

Applicant(s)

LEE ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) The amendment filed 11/09/2006 is acknowledged. Claims 2 *and* 9 have been canceled. New claims 16-20 are currently added.

2) Newly submitted claims 16-20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to an optical disc having a protection information indicates a portion of data zone is recorded and not write protected while remaining portion is not recordable and write protected, which clearly different with original claims since the original claimed are directed to an optical disc having write protection status indicates a size of write protected area and non-write protected area.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3) The I.D.S filed 12/29/2006 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they

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have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

4) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

OPTICAL RECORDING DISK HAVING WRITE PROTECTION INFORMATION.

5) Claims 1,3-8,10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1,3-8,10 and 11 recite the feature of "write protection status indicates a size of write protected area and non-write protected area " but the specification fails to provide the detail information of this important feature. Without this teaching, one of ordinary skill in the art cannot practice the invention.

Claims 12-15 recite the feature of "one of the statuses being to allow defect management of a write protected optical storage medium using a non-write protected area of the optical storage medium " but the specification fails to provide the detail information of this important feature. Without this teaching, one of ordinary skill in the art cannot practice the invention.

6) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7) Claims 1,3-8,10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,142,495. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The rejection of claims 1,3-8,10-15 as being unpatentable over claims 1-14 of S/N 10/630,922 is repeated herein since S/N 10/630,922 has been publication as US 7,142,495.

8) Claims 1,3-8,10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,862,256.

The rejection of claims 1,3-8,10-15 in previously Office action is repeated herein.

9) Claims 1,3-8,10-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/235,294.

The rejection of claims 1,3-8,10-15 in previously Office action is repeated herein.

10) Claims 1,3-8,10-15 are provisionally rejected on the ground

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of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 11/429,337.

The rejection of claims 1,3-8,10-15 in previously Office action is repeated herein.

11) Claims 1,3-8,10-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 11/235,295.

The rejection of claims 1,3-8,10-15 in previously Office action is repeated herein.

12) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

13) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14) Claims 1,3-8,10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by LEE et al (EPA, 0 965 988 A2).

The rejection of claims 1,3-8,10-15 (formerly claims 1-16) in

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previously Office action is repeated herein.

15) Applicant's arguments filed 11/09/2006 have been fully considered but they are not persuasive.

First, applicant did not response to the title as indicated in last Office action.

Second, applicant states that " the term size is amply described to meet the statutory requirements. For example, paragraph [0038] " and " various write protected areas are discussed on paragraphs [0022] and [0023] ". However, paragraph [0038] is a conclusion without any reasonable support from specification since no place in the specification specific teaching the features of " write protection status indicates a size of write protected area and non-write protected area ". Further, paragraphs [0022] and [0023] simply teach the feature of write protection information indicating that the disc is write protected in the disc identification zone, which is also not showing the feature as applicant's argued.

Third, applicant states that the reference of LEE et al (EPA 0965 988 A2) did not show write protected area and non-write protected area as claimed in claims 1 and 8. Figure 4A of LEE et al show disc write protection area b3 and non-write protection area b2

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(reserved area) and figure 5A show disc write protection area b4 and non-write protection areas b2 and b5 (reserved area). Further, the features as claimed in claim 12 is also shown in LEE et al (see figure 5A, the defect management of write protected optical disc b4 using non-write protected area b2 (reserved area b2)).

For that reasons, the claims are still rejectable as shown above.

16) THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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17) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

The FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

January 30, 2007